

Remarks

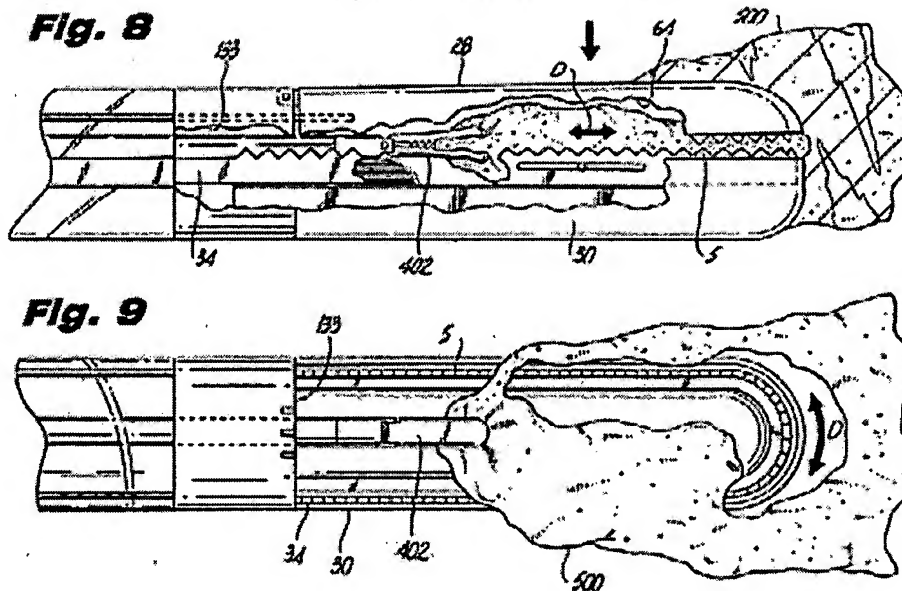
Claims 11-14 are cancelled without prejudice to their inclusion in a divisional application.

Claims 1-3, 6 and 8 were rejected for obvious-type double patenting over several claims of co pending U.S. Patent Application No. 10/365,809 ("the '809 Application"). Claim 1 is patentably distinct from the '809 Application, where Claim 1, as amended, describes a guide tube extending from the distal end through an opening of the instrument's shaft, a path through at least the guide tube for extending a guide wire, in which the guide tube extends beyond the instrument's distal end and the blade when retracted to define a path along which the blade is extendable and retractable. The guide tube, the path for extending the guide wire, the path defined by the guide tube extending beyond the distal end of the instrument, and the blade of Claim 1 are not described or suggested by '809 Application. Thus, Claim 1 and its dependent Claims 2, 3, and 6 cannot be an obvious variation of any claim of the '809 Application, and Claim 1 must be patentably distinct from the '809 Application. Claim 8, as amended, describes a guide tube, a movable blade shuttle having a blade, in which the guide tube extends beyond the instrument's distal end and the blade shuttle when retracted to define a path along which the blade shuttle is extendable and retractable. Where such guide tube and blade shuttle of Claim 8 are not described or suggested by the '809 Application, Claim 8 cannot be an obvious variation of any claim of the '809 Application, and Claim 8 must be patentably distinct from the '809 Application. Withdrawal of the obvious-type double patenting rejection is thus requested.

Claims 1-10 were rejected as being anticipated by Sauer et al., U.S. Patent No. 5,562,694 ("Sauer"). This rejection is respectfully traversed. Sauer describes that "the portion of the elongated blade member 34 disposed in the inner cavity 72 of the lower jaw member 30 is provided with a plurality of teeth 5 configured to engage and cut tissue in response to translational movement of the cutting blade 34" (see column 6, lines 10-14). The operation of blade (34) is further described at column 10, lines 1-8, in connection with FIGS. 8 and 9 as follows:

Referring to FIGS. 8 and 9, morcellation of the target tissue 500 is achieved by actuating the handle member 32 in the direction indicated by arrow "C" (see FIG. 4) which effectuates the arcuately configured cutting blade 34 to translate in the direction indicated by arrow "D", whereupon the cutting blade 34 cuts and separates the target tissue 500 within the rigid inner cavities 64, 72 of the cooperating jaw members 28, 30 from a tissue body.

See also FIGS. 8-9 of Sauer copied below.



It is the Examiner position that the claimed guide tube is located “to the left side of element 402”. However, the part of the figure to the left of tool member (402) is either part of the tool member (402) or the path for such tool member in Sauer’s instrument. Sauer explains at column 9, lines 52-54, and shows in FIG. 4 that the “[t]he tool member 402” is for engaging “target tissue 500 through manipulation of the handle mechanism (410) of the surgical grasping instrument 400”. Thus, the tool member (402) cannot represent the claimed guide tube defining the path of its blade (34) with teeth (5).

Moreover, Claim 1 describes the guide tube as extending beyond both the instrument’s distal end and blade, when the blade is retracted, to define a path along which the blade is extendable and retractable. Clearly there is no guide tube in Sauer with regards to its blade (34) that extends beyond its instrument’s distal end and its blade, when retracted or otherwise (see extent of blade’s teeth (5) in FIG. 8 above). Even if the tool member (402) represented a guide tube, it would be antithetical to suggest in Sauer that such tool member (402) would extend beyond blade’s teeth (5) when the blade (34) is cutting tissue, since the tool member (402) may interfere with the cutting action of the blade as indicated by (D) in above FIGS. 8-9.

Furthermore, there is no path of Claim 1 described, or even suggested, in Sauer for extending any guide wire through a guide tube. Accordingly, Claim 1 cannot be anticipated in view of

Sauer as each and every element is not present in Sauer, and withdrawal of the rejection of Claim 1 and its dependent Claims is requested.

Claim 8, as amended, describes a movable blade shuttle having a blade in which a guide tube extends through the shaft's opening beyond the instrument's distal end and blade shuttle, when retracted, to define a path along which the blade shuttle is extendable and retractable. Sauer lacks the Claim 8 guide tube and blade shuttle, since there is no description in Sauer of any guide tube having a path beyond its instrument's distal end along which its blade travels. Thus, Claim 8 cannot be anticipated in view of Sauer, and withdrawal of the rejection of Claim 8 and its dependent Claims is requested.

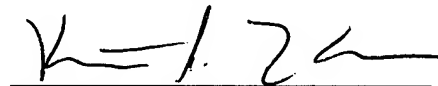
Amendments made to Claims 4-6 are made to clarify the invention, and not to overcome any rejection.

Claims 15-26 are added for consideration of the Examiner. Claims 15-24 are dependent on respective base Claims 1 or 8 which are believed allowable for reasons argued above. Claim 25 is a new independent claim which is patentable over Sauer since Sauer does not describe or suggest any guide member extending from the instrument's distal end beyond a shaft and a blade disposed for traveling along such guide member out from such shaft to cut tissue located outside of the instrument. Claim 26 is dependent on Claim 25 and further describes the guide member. Thus, Claims 25 and 26 should also be allowable.

It is believed the application is in condition for allowance, and a notice of allowance is respectfully solicited. A petition for a one-month extension of time is enclosed with a check for \$110.00 for the petition fee and additional claim fee.

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Respectfully submitted,



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Enclosures: Combined Amendment Transmittal and Petition for Extension of Time with a
Check for \$110.00